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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,576	11/17/2006	Thomas Buchberger	R.304929	1291
2119	7590	01/15/2009		
RONALD E. GREIGG GREIGG & GREIGG P.L.L.C. 1423 POWHATAN STREET, UNIT ONE ALEXANDRIA, VA 22314			EXAMINER CHAUDRY, ATIF H	
			ART UNIT 3753	PAPER NUMBER
			MAIL DATE 01/15/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/549,576

Applicant(s)

BUCHBERGER ET AL.

Examiner

ATIF H. CHAUDRY

Art Unit

3753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22, 23, 25-27 and 29-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22, 23, 25-27 and 29-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the claims

Applicant's amendment as filed on 11/18/08 has been entered. The amendment cancelled claims 24 and 28 and amended claims 22, 25, 29, 36, and 39. Currently claims 22, 23, 25-27, 29-42 are pending in this application.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 22, 25, 27, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Cadman et al (US Pat 2498482).
3. Regarding claims 22, 25, 27, Cadman et al (Fig. 2) discloses a valve comprising a valve holder 33, a valve insert 30 screwed to the valve holder 33, a valve piston 48 supported slidably in the valve insert 30, a compression spring 50, acting upon the valve piston 48 with a pressure force acting in the closing direction, and an adjusting shim 47 disposed between the valve piston 48 and the compression spring 50 such that the compression spring 50 is braced on one end on a bottom piece of the valve holder 33 and on the other on a face of the adjusting shim 47 facing away from the valve piston 48 wherein the valve holder 33 is cup-shaped and has at least two subregions, the first subregion 35 with smaller diameter receiving the valve spring 50, and the subregions merge with one another in steplike fashion, and wherein the steplike transition of the

valve holder 33 formed by the different diameter regions is seated on the valve insert 30 such that the valve insert 30 is received in second subregion.

4. Regarding claim 35, Cadman et al discloses an outflow opening 34 in the holder 33.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 22, 23, 25, 27, 29, 30-35, 38 are alternatively rejected and claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482).

8. Regarding claims 22, 25, 27, 35, Jay et al (fig. 2, 3) discloses a pressure limiting valve comprising a valve holder 14, 15, a valve insert 10 connected to valve holder, a

piston 11, a compression spring 28 acting upon the piston 11 through an adjusting shim 25. Jay et al fails to disclose a valve holder comprising cup shaped holder having two subregions. Cadman et al (Fig. 2) teaches a valve comprising a valve holder 33, a valve insert 30 screwed to the valve holder 33, a valve piston 48 supported slidably in the valve insert 30, a compression spring 50, acting upon the valve piston 48 with a pressure force acting in the closing direction, and an adjusting shim 47 disposed between the valve piston 48 and the compression spring 50 such that the compression spring 50 is braced on one end on a bottom piece of the valve holder 33 and on the other on a face of the adjusting shim 47 facing away from the valve piston 48 wherein the valve holder 33 is cup-shaped and has at least two subregions, the first subregion 35 with smaller diameter receiving the valve spring 50, and the subregions merge with one another in steplike fashion, and wherein the steplike transition of the valve holder 33 formed by the different diameter regions is seated on the valve insert 30 such that the valve insert 30 is received in second subregion. Cadman et al teaches an outflow opening 34 in the holder 33. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a valve holder and a valve insert as taught by Cadman et al as an alternative valve housing assembly.

9. Regarding claim 23, Jay et al discloses the insert 10 having a cup shaped recess to hold the adjusting shim 25.

10. Regarding claim 29, Jay et al discloses (Fig. 6) the piston 26 comprising an end surface 36 and an outer circumferential surface having flat places 35.

11. Regarding claim 33 and 34, Jay et al discloses the adjusting shim 25 having a fluid recess 29 disposed eccentrically.
12. Regarding claim 38, Jay et al discloses an outlet 22 provided in the valve insert.
13. Regarding claim 30, Jay et al discloses two flat places uniformly distributed over the circumference of the piston (parallel in Fig. 5, oriented at angle in Fig. 3) but fail to disclose three flat places. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three flat surfaces on the piston disclosed by Jay et al, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).
14. Regarding claim 31, Jay et al (fig. 5) discloses flat places extending parallel to the axis of the piston 35.
15. Regarding claim 32, Jay et al discloses (fig. 3) flat places 36 oriented at an angle to the axis of the piston.
16. Claims 39, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482) further in view of Yie (US Patent 5241986).
17. Jay et al fails to disclose a piston rod. Yie teaches a pressure relief valve 10 comprising a piston 15 having a piston rod 17 protruding into the cup shaped recess of valve holder 11 and surrounded by a spring 22 such that the adjusting shim 18 is slipped onto the piston rod 17 and rests on a steplike seat. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided

the valve disclosed by Jay et al with a piston rod as taught by Yie in order to help align the piston and the spring.

18. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482) further in view of LINDEBOOM (US Patent 3346009).

19. Jay et al fails to disclose a conical spring. LINDEBOOM (fig. 1) teaches a pressure actuated valve comprising a piston operated by a conical spring. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a conical spring as taught by LINDEBOOM as an alternative biasing mechanism.

20. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482) further in view of Lauer et al (US Patent 6523913).

21. Jay et al fails to disclose valve parts joined together by caulking. Lauer et al (fig. 1, col 2, line 48), teaches a pressure control valve comprising a valve holder 14 and a valve insert joined together by caulking. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with caulking as a joining method as taught by Lauer et al as an alternative method of valve assembly.

22. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Cadman et al (US Pat 2498482) further in view of Weirich (US Patent 4313463).

23. Jay et al fails to disclose an outflow conduit at an angle to the longitudinal axis. Weirich (fig. 1) teaches a pressure relief valve 10 comprising a cup shaped valve holder 11 with an outer jacket face having an outflow conduit 11' at an angle relative to the longitudinal axis of the valve holder 11 connecting the outer jacket face to inside of valve. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a valve holder having outflow conduit as taught by Weirich as an alternative fluid outlet path.
24. Claim 22 is alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Jay et al (US Patent 2672881) in view of Waffler (US Patent 6953053).
25. Jay et al (fig. 2, 3) discloses a pressure limiting valve comprising a valve holder 14, 15, a valve insert 10 connected to valve holder, a piston 11, a compression spring 28 acting upon the piston 11 through an adjusting shim 25. Jay et al fails to disclose a valve holder comprising cup shaped holder having two subregions. Waffler (fig. 1) teaches a pressure relief valve comprising a cup shaped valve holder 46 and a valve insert 12 held in the valve holder, wherein the valve holder 46 comprises a smaller diameter subregion 54 and a larger diameter subregion 50 to receive the valve insert 12 such that valve is seated in the step between the two recesses. It would have been obvious to a person having ordinary skill in the art at the time of the invention to have provided the valve disclosed by Jay et al with a valve holder and insert as taught by Waffler as an alternative assembly configuration.

Response to Arguments

26. Applicant's arguments filed 11/19/2008 have been fully considered but they are not persuasive. Applicant's argument that "in Waffler element 46 is not a valve holder and element 12 is not a valve insert since it is a valve housing" is not persuasive since both elements are part of the housing such that element 12 is shown in figure 1 as inserted into the stepped portion 50 of the element 46. Cadman et al alone or Jay et al in view of Cadman et al have been cited as alternative prior art for claim 22.

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ATIF H. CHAUDRY whose telephone number is (571)270-3768. The examiner can normally be reached on Mon-Fri Alternate Friday off 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571)272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Atif H Chaudry/
Examiner, Art Unit 3753

/John Rivell/
Primary Examiner, Art Unit 3753

1/10/2009